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Mailed: 20 DEC 2002

Paper No. 12

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Del Laboratories, Inc.

Serial No. 75/778,612

David B. Kirschstein of Kirschstein, Ottinger, Israel & Schiffmiller, P.C. for Del Laboratories, Inc.

Caroline E. Wood, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Cissel, Bottorff and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 19, 1999, Del Laboratories, Inc. (applicant) filed an intent-to-use application to register the mark shown below on the Principal Register:



for "eyewear, namely, sunglasses, eyeglasses, frames, lenses, eyeglass cases and eyeglass cords" in International Class 9.¹ The application contains a disclaimer of the terms "N.Y.C." and "New York," and the drawing is lined for the colors blue, orange, and magenta.

The examining attorney refused to register applicant's mark on the ground that the mark is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act. 15 U.S.C. § 1052(e)(2). When the examining attorney made the refusal to register final, applicant filed a notice of appeal.

We affirm.

The examining attorney's position is that the mark is primarily geographically descriptive because "applicant's mark, N.Y.C. NEW YORK EYEWEAR[,] contains the name of a place known to the public, N.Y.C. NEW YORK; the other term in the mark, EYEWEAR, is generic; and the goods are manufactured[,] produced or originate in or near N.Y.C. NEW YORK." Br. at 8. Furthermore, the examining attorney found that "neither the stylization, nor the color of the proposed mark make it inherently distinctive." Br. at 7. Therefore, the examining attorney concluded that the mark was not registrable on the Principal Register.

¹ Serial No. 75/778,612.

Applicant "concedes that New York City is a famous city, that the letters 'NYC' are an abbreviation for New York City and that the words 'New York' are often used to mean not just New York City but New York State." Br. at 2. However, applicant argues that the mark as a whole is not primarily geographically descriptive because "a consumer viewing a product bearing the mark would not immediately come to the conclusion that the product was made in New York City but would understand the mark as meaning a product from a particular source which partakes of the special ambiance and/or fashion associated with New York City - vivid and exciting." Br. at 2. Applicant concludes by arguing that its mark "constituting a distinctive design comprising the words 'N.Y.C.' and 'New York' and the word 'Eyewear' is not primarily geographically distinctive." Br. at 4.

The Board has set out the following test to use in determining whether a mark is primarily geographically descriptive:

[T]he Trademark Examining Attorney would need to submit evidence to establish a public association of the goods with that place if, the place named in the mark may be so obscure or remote that purchasers would fail to recognize the term as indicating the geographical source of the goods to which the mark is applied or (2) an admitted well-recognized term may have other meanings, such that the term's geographical significance may not be the primary significance to

prospective purchasers. Where, on the other hand, there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote, a public association of the goods with the place may ordinarily be presumed from the fact that the applicant's goods come from the geographical place named in the mark.

In re Handler Fenton Westerns, Inc., 214 USPQ 848, 849-50

(TTAB 1982).

Furthermore, the Federal Circuit has quoted the Board as correctly saying:

[H]ere a refusal of registration is based on the finding that a mark is primarily geographically descriptive of the goods, that is, the goods actually come from the geographical place designated in the mark, the Examining Attorney must submit evidence to establish a public association of the goods with the place if, for example, there exists a genuine issue raised that the place named in the mark is *so obscure or remote that purchasers would fail to recognize* the term as indicating the geographical source of the goods.

In re Societe Generale Des Eaux Minerales de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450, 1451 (Fed. Cir. 1987) (emphasis in original).

We can presume that there is such a relationship if the goods or services come from that place, and the place is not remote and obscure. See Vittel and Handler Fenton. In this case, the examining attorney has submitted evidence in the form of dictionary definitions of the terms, "New York," "New York City" and "N.Y.C." and applicant "readily

concedes that New York City is famous, that the letters 'NYC' are an abbreviation for New York City and that the words 'New York' are used to mean not just New York City but New York State." Br. at 2. Thus, it is clear that New York is not a remote or obscure place. Also, applicant is located in New York in Uniondale, which the examining attorney has pointed out is in southeastern New York on Long Island. See Office Action dated December 19, 2001, attachment. Therefore, we can also presume that applicant's goods come from the New York City area, and applicant has appropriately disclaimed these geographically descriptive terms.²

There also does not seem to be any dispute that the term "eyewear" does not change the wording from primarily geographically descriptive wording to inherently distinctive wording. While the examining attorney has not requested that applicant disclaim the term "eyewear,"³ it is clear that the examining attorney considered the term to be

² Accord In re Wada, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (Federal Circuit affirmed a Board's decision refusing registration for the mark NEW YORK WAYS GALLERY on the ground that the mark was primarily geographically deceptively misdescriptive for various kinds of leather bags that did not come from New York).

³ If applicant overcomes the refusal to register and its mark is forwarded for publication, the application must be remanded to the examining attorney for a disclaimer of the term "eyewear."

highly descriptive or even generic. See Br. at 5 ("The term 'EYEWEAR' ... is highly descriptive or generic"); Office Action dated March 22, 2000, p. 2 ("Because the term 'eyewear' is generic for the applicant's goods"). Highly descriptive or generic wording does not convert a geographically descriptive term into a non-geographic term. In re Compagnie Generale Maritime, 993 F.2d 841, 26 USPQ2d 1652, 26 USPQ2d 1652 (Fed. Cir. 1993) (FRENCH LINE (stylized) primarily geographically descriptive of goods and services from France); In re Cambridge Digital Systems, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design primarily geographically descriptive when applicant's place of business is Cambridge, Massachusetts); In re Carolina Apparel, 48 USPQ2d 1542, 1543 (TTAB 1998) ("The addition of a generic term to a geographic term does not avoid the refusal of primary geographic descriptiveness").

The central issue in this appeal is whether the design of applicant's mark is inherently distinctive. Applicant argues that "the overwhelming majority of people would view the present design as being inherently distinctive." Response dated September 17, 2001, p. 2. "When words, which are merely descriptive, and hence unregistrable, are presented in a distinctive design, the design may render

the mark, as a whole registrable, provided that the words are disclaimed." In re Clutter Control, Inc., 231 USPQ 588, 589 (TTAB 1986). In that case, the Board found that "the tube-like rendition of the letter 'C' in the words 'construct' and 'closet' make a striking commercial impression." Id.

In this case, we do not view applicant's design as making a striking commercial impression. Indeed, applicant's basic block design is even less distinctive than the script that the CCPA found registrable on the Supplemental Register in In re Wella Corp., 565 F.2d 143, 196 USPQ 7 (CCPA 1977).



Inasmuch as applicant is seeking registration on the Principal Register without a claim of acquired distinctiveness, applicant's burden is significantly greater than the applicant in Wella.

The next question is whether the lining for the colors blue, orange, and magenta results in a non-inherently distinctive mark becoming inherently distinctive. We hold

that in this case it does not. The examining attorney has rejected applicant's argument that its design negates the geographical descriptiveness of the mark because she found that "the mark is shown only in large capital colored letters which are not distinctive."⁴ Final Office Action, p. 2.

[I]t has generally been held over the years that the distinctive display of descriptive or otherwise unregistrable components of a mark cannot bestow registrability upon the mark as a whole unless the features are of such a nature that they undoubtedly would serve to distinguish the mark in its entirety in the applicable field or it can be shown through competent evidence that the unitary mark as a whole displayed in the asserted distinctive manner does in fact create a distinctive commercial impression separate and apart from and above the descriptive significance of its components.

⁴ The examining attorney also argued that "the Supreme Court has determined that multiple color marks are never inherently distinctive, and cannot be registered on the Principal Register without a showing of acquired distinctiveness," citing Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 54 USPQ2d 1065 (2000). Br. at 7. This statement is an overly broad reading of the Supreme Court case law. The Supreme Court has explained that "a product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs, which almost automatically tell a customer that they refer to a brand." Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 34 USPQ2d 1161, 1162 (1995) (emphasis in original). Subsequently, in a case involving trade dress, the Court explained that, "with respect to at least one category of marks--colors--we have held that no mark can ever be inherently distinctive." Wal-Mart, 54 USPQ2d at 1068. The Court went on to explain that in Qualitex, it "held that a color could be protected as a trademark but only upon a showing of secondary meaning ... Because a color, like a 'descriptive word' word mark, could eventually 'come to indicate a product's origin.'" Id. (emphasis added). Clearly, the Court was speaking in the context of a single color applied to a product in a trade dress context. This case does not hold that color in any context, including as part of a display of a word mark, could never be inherently distinctive.

In re Behre Industries, Inc., 203 USPQ 1030, 1032 (TTAB 1979).

It is certainly common for trademark owners to display their marks in a variety of different ways. See, e.g., In re Northland Aluminum Products, Inc., 777 F.2d 1561, 227 USPQ 961, 964 (Fed. Cir. 1985) (Court agreed with Board that lettering of BUNDT mark does not create a commercial impression separate and apart from the term); United States Lines, Inc. v. American President Lines, Ltd., 219 USPQ 1224 (TTAB 1982) (Applicant's THRUSERVICE mark with stylized "S" is not inherently distinctive); In re Couriare Express International, Inc., 222 USPQ 365 (TTAB 1984) (Slightly slanted letters and capitalization of the letters "C" and "A" in COURIAIRE not distinctive); In re Miller Brewing Co., 226 USPQ 666 (TTAB 1985) (Stylized mark LITE not inherently distinctive; evidence of acquired distinctiveness persuasive); In re S.D. Fabrics, Inc., 223 USPQ 54 (TTAB 1984) (Filling in some of the letters with shading and presenting the mark as "designers/fabric" are not so distinctive as to create a commercial impression separate and apart from the unregistrable components; In re Anchor Hocking Corp., 223 USPQ 85, 88 (TTAB 1984) (Stylization is completely ordinary and nondistinctive);

In re Geo. A. Hormel & Co., 227 USPQ 813, 814 (TTAB 1985)) (Applicant's stylized script "plainly not inherently distinctive"); and In re Guilford Mills Inc., 33 USPQ2d 1042, 1044 (TTAB 1994) (Board rejected applicant's argument that interlocking letters in its mark "cleverly suggest" applicant's goods).

Here, applicant's presentation of its mark is in an unremarkable block style. The only feature not entirely ordinary about its block letters is the fact that they are shown in three different colors. We can hardly conclude that this feature creates such an impression that it would convert a non-registrable term into an inherently distinctive one. "The important point is, of course, the effect the display is likely to have on the prospective purchaser of the goods." Couriare, 222 USPQ at 366. The display here is not unlike other designs that have been held to lack inherent distinctiveness. Potential consumers are unlikely to see slight changes in the presentation of the mark such as shading, lack of capitalization, and the addition of a slash (S.D. Fabrics); the display of the mark with flames (Behre); or the use of interlocking letters (Guilford Mills), as creating an inherently distinctive mark. We conclude that similarly applicant's mark would not create a distinctive commercial impression.

Applicant raises two other points in its brief in support of its argument that the refusal should be reversed.⁵ First, applicant notes that there are "many registrations including city names which have been granted without resort to Section 2(f)." Br. at 3. Almost all of these registrations and applications contain a disclaimer of the city name or other inherently distinctive matter or they are registered under Section 2(f). Furthermore, even if some of the registrations supported applicant's argument, the "PTO's allowance of such prior registrations does not bind the Board or this court." In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Finally, applicant refers to its registration for the mark N.Y.C. NEW YORK COLOR in a similar design for goods in International Class 3.⁶ That registration is for a different mark, so it cannot control the outcome of this case. In re Loew's Theatres, Inc., 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985) (Applicant's incontestable registration for the mark DURANGOS for cigars did not

⁵ Applicant submitted evidence and attachments with its Brief. While this evidence is clearly untimely, inasmuch as the examining attorney has not objected and, in fact, discussed much of the evidence in her brief, we will consider this evidence.

⁶ Applicant's application for the mark N.Y.C. NEW YORK COLOR for eyewear is also not persuasive inasmuch as the mark is different from the mark applicant is seeking in this case.

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eliminate requirement for applicant to establish
distinctiveness for its mark DURANGO for chewing tobacco).

DECISION: The refusal to register applicant's mark
for the identified goods is affirmed.